UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/339,733	06/24/1999	SCOTT C. COTTRILLE	777.209US1	2967

26389 7590 03/22/2005

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

EXAMINER	
YUAN, ALMARI ROMERO	
ART UNIT	**PAPER NUMBER**
2176	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/339,733	COTTRILLE ET AL.	
	Examiner	Art Unit	
	Almari Yuan	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: After Final Response filed on 12/13/04.

2. The rejection of claims 1-28 under 35 U.S.C. 103(a) as being unpatentable over Eintracht and deVries has been withdrawn in light of newly found art.

3. Claims 1-28 are pending in the case. Claims 1, 10, 22, 23, 24, and 25 are independent claims.

Response to Amendment

4. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 1, 4-15, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaLiberte et al., "A Protocol for Scalable Group and Public Annotations", printed on 10/1998, <www.hypernews.org>, pages 1-9 (submitted by Applicant in IDS filed on 6/24/1999) in view of MacNaughton et al. (USPN 6,020,884 – filed on 08/1998 –previously cited by the Examiner in the PTO-892 mailed on 9/05/02).**

Regarding independent claim 1 and (dependent claims 4-7), LaLiberte discloses:

A computing system for scalably managing annotations, the computing system comprising:

a tier III server for storing annotations (LaLiberte on page 1, 3rd paragraph, on page 4, 1st paragraph, and on page 6, 2nd paragraph teaches annotation server (tier III) for storing annotations);

a tier I server for determining if a content source has an index of the annotations stored on the tier II server, that is separate and distinct from the tier II and tier III servers (LaLiberte on page 3, 1ast paragraph, on page 4, 3rd paragraph, and on page 5, 2nd paragraph teaches document server or a HTTP server (tier I) determines by reference where the requested annotation associated with the document is located; wherein the reference to the annotation server could be stored in the metadata of the document; the document server is in communication with the public or group annotation servers).

Further, LaLiberte teaches the servers can be replicated servers to reduce load on any one server and wherein the annotation server may be relocated or replicated independently of the document servers (on page 2, 4th paragraph, page 3, last paragraph, and page 4, 2nd paragraph).

However, LaLiberte does not explicitly disclose "a tier II server for storing an index of the annotations stored on the tier III server".

MacNaughton on col. 8, lines 10-27, see Figures 1A-1B teaches the Community Server 18 (Fig. 1A) interacts with URL database 40 (Fig. 1B) to determine whether annotations are available for a particular URL; the Community Server (tier II) interacts with the Threaded Message Server 54 (Fig. 1B) (tier III) to locate the message associated with the URL.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified MacNaughton into LaLiberte to provide a URL database coupled to the Community Server that provides URLs to locate messages stored on the Threaded Message Server, as taught by MacNaughton, incorporated into the scalable annotation system of servers in LaLiberte, in order to facilitate the retrieval of requested annotations among a network of servers.

Regarding dependent claims 9 and 28, LaLiberte discloses:

wherein the document identifier is selected from the group consisting of: a directory path, a uniform resource locator, and a file name (LaLiberte on page 4, 1st paragraph teaches URL of an annotation).

Regarding independent claim 10 and (dependent claims 11-15), LaLiberte discloses:

A scalable computerized method of posting an annotation, the method comprising:

sending an annotation post from a client to a tier III server; storing a portion of the annotation post on the tier III server (LaLiberte on page 6, last paragraph teaches post an annotation either at the document server or via local NNTP server and on page 4, 1st paragraph teaches the bodies of annotation are stored on the annotation server (tier III server));

sending association information from the tier II server to a tier I server that is separate and distinct from the tier II and tier III servers; and storing the association information of the tier I server (LaLiberte on page 3, 1ast paragraph, on page 4, 3rd paragraph, and on page 5, 2nd paragraph teaches the reference to the annotation server could be stored in the metadata of the document; the document server is in communication with the public or group annotation servers).

However, LaLiberte does not explicitly disclose "sending and storing a second portion of the annotation post on the tier II server".

MacNaughton on col. 21, line 52 – col. 23, line 33 teaches posting messages and on col. 8, lines 10-27, see Figures 1A-1B teaches the Community Server 18 (Fig. 1A) interacts with URL database 40 (Fig. 1B) which stores URLs associated with the messages stored in the Threaded Message Server.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified MacNaughton into LaLiberte to provide a URL database and Community Server for storing URLs to locate messages stored on the Threaded Message Server, as taught by MacNaughton, incorporated into the scalable annotation system of servers in LaLiberte, in order to facilitate the retrieval of requested annotations among a network of servers.

Regarding independent claim 25 and (dependent claim 8), LaLiberte discloses:

A scalable computerized method for managing annotations, the method comprising:

LaLiberte discloses "storing within tier I server reference that identifies a tier III server", on page 5, 2nd paragraph teaches HTTP server identifies the annotation server with the URL; wherein URL was retrieved from the requested document.

LaLiberte discloses "storing annotation associated with content source" on page 1, 3rd paragraph, on page 4, 1st paragraph, and on page 6, 2nd paragraph teaches annotation server (tier III) for storing annotations.

LaLiberte discloses "response of associations for the document identifier and reference", on page 3, 1ast paragraph, on page 4, 3rd paragraph, and on page 5, 2nd paragraph teaches the reference to the annotation server could be stored in the metadata of the document; the document server (tier I) is in communication with the public or group annotation servers (tier III), in other words, the document is stored in the document server that may have an associated annotation stored in the annotation servers.

Further, LaLiberte discloses "servers are distinct from each other" on page 2, 4th paragraph, page 3, last paragraph, and page 4, 2nd paragraph he servers can be replicated servers to reduce load on any one server and wherein the annotation server may be relocated or replicated independently of the document servers.

However, LaLiberte does not explicitly disclose "a tier II server for storing an index of the annotations stored on the tier III server".

MacNaughton on col. 8, lines 10-27, see Figures 1A-1B teaches the Community Server 18 (Fig. 1A) interacts with URL database 40 (Fig. 1B) to determine whether annotations are available for a particular URL; the Community Server (tier II) interacts with the Threaded Message Server 54 (Fig. 1B) (tier III) to locate the message associated with the URL.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified MacNaughton into LaLiberte to provide a URL database coupled to the Community Server that provides URLs to locate messages stored on the Threaded Message Server, as taught by MacNaughton, incorporated into the scalable annotation system of servers in LaLiberte, in order to facilitate the retrieval of requested annotations among a network of servers.

Regarding dependent claims 26, LaLiberte discloses communication between the HTTP server and the annotation server; wherein the document identifier and reference can be found within the requested document along with the Annotations_CGI header (see page 5).

Regarding dependent claim 27, LaLiberte discloses the annotation server returns the requested information or document to the client with hyperlinks for each annotation or bodies of all annotations (see page 6, 1st paragraph – 3rd paragraph).

7. **Claims 2-3 and 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaLiberte and MacNaughton, as applied to claims 1, 4-15, and 25-28 above, and further in view of Eintracht et al. (USPN 6,687,878 B1 – filed on 03/1999).**

Regarding independent claim 22 and (dependent claims 3, 16-18), LaLiberte discloses:

A computer-readable medium having stored thereon a "client-to-tier III server"data structure for scalable annotations comprising:

LaLiberte discloses an annotation server (tier III) for storing annotations, on page 1, 3rd paragraph, on page 4, 1st paragraph, and on page 6, 2nd paragraph.

LaLiberte discloses "receiving and storing portion of the post of the annotation", on page 6, last paragraph teaches post an annotation either at the document server or via local NNTP server and on page 4, 1st paragraph teaches the bodies of annotation are stored on the annotation server (tier III server) and can post just the URL of the annotation.

LaLiberte discloses "receiving and storing associations for the annotation", on page 3, last paragraph, on page 4, 3rd paragraph, and on page 5, 2nd paragraph teaches the reference to the annotation server could be stored in the metadata of the document; the document server (tier I) is in communication with the public or group annotation servers (tier III), in other words, the document is stored in the document server that may have an associated annotation stored in the annotation servers).

Further, LaLiberte discloses "servers are distinct from each other" on page 2, 4th paragraph, page 3, last paragraph, and page 4, 2nd paragraph he servers can be replicated servers to reduce load on any one server and wherein the annotation server may be relocated or replicated independently of the document servers.

However, LaLiberte does not explicitly disclose "receiving and storing a portion of the annotation post on the tier II server".

MacNaughton on col. 21, line 52 – col. 23, line 33 teaches posting messages and on col. 8, lines 10-27, see Figures 1A-1B teaches the Community Server 18 (Fig. 1A) interacts with URL database 40 (Fig. 1B) which stores URLs associated with the messages stored in the Threaded Message Server.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified MacNaughton into LaLiberte to provide a URL database and Community Server for storing URLs to locate messages stored on the Threaded Message Server, as taught by MacNaughton, incorporated into the scalable annotation system of servers in LaLiberte, in order to facilitate the retrieval of requested annotations among a network of servers.

However, LaLiberte and MacNaughton do not explicitly disclose "a data structure of fields containing context document identifier, a body of the annotation, generic properties, and specific properties of the annotation".

Eintracht has the capability in posting annotations (see Abstract) and also discloses data structures of fields in relation to the annotation as shown in Figures 10-13. Eintracht on col. 16, line 67 – col. 17, line 15, col. 18, lines 18-35 teaches a note data structure comprising a plurality of fields such as Document ID field; the text (content of the note); note anchor; note time stamp...(generic and type specific properties).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Eintracht into LaLiberte and MacNaughton, to provide a data structure of fields, as taught by Eintracht, incorporated into the server systems of LaLiberte and MacNaughton, in order to facilitate the differentiation of notes or annotations when generated by various users.

Regarding independent claim 23 and (dependent claims 2, 19-20), LaLiberte discloses:
A computer-readable medium having stored thereon a "tier IIII server-to-tier II server" data structure for scalable annotations, comprising:

LaLiberte discloses "post of the annotation", page 6, last paragraph teaches post an annotation either at the document server or via local NNTP server.

LaLiberte discloses "tier III servers" on page 4, 1st paragraph teaches the bodies of annotation are stored on the annotation server (tier III server) and can post just the URL of the annotation.

LaLiberte discloses "receiving and storing associations for the annotation", on page 3, last paragraph, on page 4, 3rd paragraph, and on page 5, 2nd paragraph teaches the reference to the annotation server could be stored in the metadata of the document; the document server (tier I) is in communication with the public or group annotation servers (tier III), in other words, the document is stored in the document server that may have an associated annotation stored in the annotation servers.

Further, LaLiberte discloses "servers are distinct from each other" on page 2, 4th paragraph, page 3, last paragraph, and page 4, 2nd paragraph he servers can be replicated servers to reduce load on any one server and wherein the annotation server may be relocated or replicated independently of the document servers.

However, LaLiberte does not explicitly disclose "receiving and storing a portion of the annotation post on the tier II server".

MacNaughton on col. 21, line 52 – col. 23, line 33 teaches posting messages and on col. 8, lines 10-27, see Figures 1A-1B teaches the Community Server 18 (Fig. 1A) interacts with URL database 40 (Fig. 1B) which stores URLs associated with the messages stored in the Threaded Message Server.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified MacNaughton into LaLiberte to provide a URL database and Community Server for storing URLs to locate messages stored on the Threaded Message Server, as taught by MacNaughton, incorporated into the scalable annotation system of servers in LaLiberte, in order to facilitate the retrieval of requested annotations among a network of servers.

However, LaLiberte and MacNaughton do not explicitly disclose "a data structure of fields containing context document identifier and generic properties".

Eintracht has the capability in posting annotations (see Abstract) and also discloses data structures of fields in relation to the annotation as shown in Figures 10-13. Eintracht on col. 16, line 67 – col. 17, line 15, col. 18, lines 18-35 teaches a note data structure comprising a plurality of fields such as Document ID field; note anchor; note time stamp...(generic properties).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Eintracht into LaLiberte and MacNaughton, to provide a data structure of fields, as taught by Eintracht, incorporated into the server systems of LaLiberte and MacNaughton, in order to facilitate the differentiation of notes or annotations when generated by various users.

Regarding independent claim 24 and (dependent claim 21), LaLiberte discloses:

A computer-readable medium having stored thereon a "tier II server-to-tier I" server data structure for scalable annotations comprising:

LaLiberte discloses "receiving and storing associations for the annotation", on page 3, last paragraph, on page 4, 3rd paragraph, and on page 5, 2nd paragraph teaches the reference to the annotation server could be stored in the metadata of the document; the document server (tier I) is in communication with the public or group annotation servers (tier III), in other words, the document is stored in the document server that may have an associated annotation stored in the annotation servers.

Further, LaLiberte discloses "servers are distinct from each other" on page 2, 4th paragraph, page 3, last paragraph, and page 4, 2nd paragraph he servers can be replicated servers to reduce load on any one server and wherein the annotation server may be relocated or replicated independently of the document servers.

However, LaLiberte does not explicitly disclose "storing indexing identifier and indexing the annotation".

MacNaughton on col. 21, line 52 – col. 23, line 33 teaches posting messages and on col. 8, lines 10-27, see Figures 1A-1B teaches the Community Server 18 (Fig. 1A) interacts with URL database 40 (Fig. 1B) which stores URLs associated with the messages stored in the Threaded Message Server.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified MacNaughton into LaLiberte to provide a URL database and Community Server for storing URLs to locate messages stored on the Threaded Message Server, as taught by MacNaughton, incorporated into the scalable annotation system of servers in LaLiberte, in order to facilitate the retrieval of requested annotations among a network of servers.

However, LaLiberte and MacNaughton do not explicitly disclose "a data structure of fields".

Eintracht has the capability in posting annotations (see Abstract) and also discloses data structures of fields in relation to the annotation as shown in Figures 10-13. Eintracht on col. 16, line 67 – col. 17, line 15, col. 18, lines 18-35 teaches data structure comprising a plurality of fields such as Document ID field; the text; note anchor; note time stamp...).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Eintracht into LaLiberte and MacNaughton, to provide a data structure of fields, as taught by Eintracht, incorporated into the server systems of LaLiberte and MacNaughton, in order to facilitate the differentiation of notes or annotations when generated by various users.

Response to Arguments

8. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is 571-272-4104. The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

X. L. Bautista
Primary Examiner
Art Unit 2179

A. Yuan
Patent Examiner
Art Unit 2176

AY
March 21, 2005